UNITED STATES PATENT AND TRADEMARK OFFICE

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09/765,985	01/19/2001	Michael A. Sharp	8247-82809-01	1204

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KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND, OR 97204

EXAMINER
MITTAL, KRISHAN K

ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tanya.harding@klarquist.com
docketing@klarquist.com

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/765,985	SHARP, MICHAEL A.
	Examiner	Art Unit
	Kris Mittal	3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 February 2011</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>35-49</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>35-49</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1.   This communication is in response to the amendment filed on February 25, 2011.

Claims 35-37 have been amended. Claims 1-34 are cancelled. New Claims 38-49 are

added. This is a final office action. Claims 35-49 are pending and have been considered

below.

Claim Rejections – 35 USC § 102 and USC § 103

2.   Office action dated November 8, 2010 rejected claims 35-37 under 35 USC 102

and 103 as anticipated and unpatentable of Tsutsui et al., U.S. Patent No. 6,963,860.

The Affidavit, under CFR 1.131, filed by the Applicant on February 25, 2011

successfully overcomes the filing date of August 12, 1999 of the Tsutsui reference.

Examiner hereby withdraws rejections *referring to Tsutsui.*

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   **Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being**

indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

As to claim 43, the claim recites wherein advertising content can not be *easily*

removed from the combined audio file. The use of the term 'easily' is subjective and,

therefore, indefinite.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in
> public use or on sale in this country, more than one year prior to the date of application for patent in
> the United States.

6.   **Claims 35, 39-40, 44-45 and 48 are rejected under 35 U.S.C. 102(b) as being**

anticipated by Logan et al., U.S. Patent No. 5,721,827 (hereinafter referred to as

Logan).

As to claim 35, Logan discloses a method of combining at least two audio

files containing media into a single combined audio file, the method comprising:

receiving a first audio file that contains advertising content (Fig. 1, database 135;

col. 4, lines 41-43: program segments which present advertising (resident in database

135) may consist of audio segment) from a first party;

receiving a second audio file that includes non-advertising content (Fig. 1,

database 131; col. 4, lines 24-25: collection of audio program segments 131; lines 28-

29: program segments comprise audio voice and music files) from a second party;

creating a combined audio file from the first and second audio files (col. 5, lines 31-36: download processing extracts from the library data defining compressed program, advertising and glue segments based on selections made by the user; Fig. 2, block 207 and col. 6, lines 57-60: server then compiles file for downloading to the subscriber at step 207 which include programming and advertising segments), the combined audio file being a single digital file that includes the advertising content of the first audio file and the non- advertising content of the second audio file (col. 5, lines 20-28: the host server periodically transmits a **download compilation file 145;** the file 145 is in a predetermined file directory; download compilation 145 is transferred to the program data source 107 in the player 103);

making the combined audio file accessible for download (col. 4, lines 3-14: the player includes modem for downloading the program information; the modem is connected to an Internet service provider which provides access to the Internet; the service provider, in turn, is connected to the host server via an Internet link) to a plurality of users via a computer network;

transmitting (col. 5, lines 20-21: the host server periodically transmits a download compilation file upon receiving a request) the combined audio file to at least one device (col. 3, lines 1-3: the player 103 may be implemented by a laptop or a desktop personal computer) where the entire combined audio file is saved (col. 5, lines 27-28: the download compilation is transferred to the program data store 107 – *saved* – in the player 103; col. 7, lines 1-3: and moved from the storage unit 145 into local storage at 107) for later playback (col. 32, lines 54-55: user may navigate a playback session);

receiving a payment from the first party (col. 27, lines 20-23: advertisers can obtain detailed billing records; paying for advertising known to have been delivered) for inclusion of the first audio file with the combined audio file; and

distributing at least a portion of the payment as a royalty payment to the second party (col. 15, lines 40-41: royalty payments due to content providers) for the inclusion of the second audio file with the combined audio file, and

wherein the combined audio file is made accessible for **download free of charge** (col. 21, lines 47-50: a charge level value of zero indicates that the subscriber desires to pay the minimum charge and correspondingly is willing to accept sufficient advertising content to achieve that goal) to the plurality of users. Examiner notes that charge level zero indicates content is provided free of charge.

As to claim 39, Logan discloses the method of claim 35 (as rejected above) and further discloses, wherein the act of receiving the first audio file comprises:

accepting an upload of the first audio file (col. 5, lines 53-67: this upload occurs at the same time a player establishes a download connection and occurs prior to the download of the compilation; programming, in addition to the specifically requested programming, are appended to the compilation) over a computer network. Examiner notes the appended content includes advertising. Moreover, Wolfe also discloses accepting upload of first audio file (col. 3, lines 33-46: dossiers may change with resulting change in advertisement programming).

As to claim 40, Logan discloses the method of claim 35 (as rejected above) and further discloses, wherein the act of receiving the second audio file comprises:

accepting an upload of the second audio file (col. 5, lines 53-67: this upload occurs at the same time a player establishes a download connection and occurs prior to the download of the compilation) over a computer network. In addition, Wolfe also discloses accepting upload of second audio file (col. 3, lines 33-46: dossiers may change with resulting change in programmed music).

As to claim 44, Logan discloses the method of claim 35 (as rejected above) and further discloses, wherein the second audio file comprises a musical composition (col. 4, lines 28-30: audio voice and music files; col. 28, lines 59-63: a program compilation might consist of country music, classical music).

As to claim 45, Logan discloses the method of claim 35 (as rejected above) and further discloses, wherein the creation of the combined audio file comprises:

appending the first audio file to the second audio file (col. 5, lines 31-36: download processing extracts from the library data defining compressed program, advertising and glue segments based on selections made by the user; lines 59-67: program segments newly requested by the user care appended to the compilation), and

saving the second audio file with the appended first audio file as a new audio file (Fig. 1, block 145; col. 5, lines 37-40: the download compilation file takes the form of one or more session specific files which contain the identification of separately stored

files; col. 7, line 2: storage unit 145; lines 1-3: moved into local storage at 107), the new

audio file being the combined audio file.

As to claim 48, Logan discloses the method of claim 35 (as rejected above) and

further discloses, wherein the at least one device comprises a user's computer (col. 3,

lines 1-2: the player may be implemented by a laptop or desktop personal computer).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   **Claims 37 and 46-47 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Logan et al., U.S. Patent No. 5,721,827 (hereinafter referred to

as Logan).

As to claim 37, Logan discloses the method of claim 35 (as rejected above) and

further discloses, the combined audio file is configured so that each time it is played

from a saved location on the device, both the first and second audio files are played

(col. 6, lines 58-60: include programming and advertising segments; col. 6, line 65 – col.

7, line files containing programming and advertising segments are moved from FTP

server to local storage in the client/player).

Logan does not explicitly disclose, wherein the saved combined audio file can be

played back repeatedly on the device. However, Logan discloses local storage of

combined file (col. 7, lines 1-3: and moved from the storage unit 145 into local storage

at 107) and subscriber ability to replay program (col. 14, lines 13-27: a Back segment

command which resets the playback point to the beginning of the prior segment;

transition is made to the prior segment). Examiner notes that it is obvious that program

stored locally can be played repeatedly by a subscriber.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention for Logan to explicitly provide for playing of the combined audio file

repeatedly by a subscriber so that a subscriber could listen to the content of choice,

from local storage, as often as desired thus making the system attractive to subscribers

and to the advertisers for repeated exposure to the advertisement.

As to claim 46, Logan disclose the method of claim 35 (as rejected above) but

does not explicitly disclose, wherein the second audio file consists of a music single of

one song. However, Logan discloses audio program segments (col. 3, lines 56-60:

program topic description describes content of each individual program; col. 4, lines 28-

30: audio program segments comprise music files; col. 28, lines 59-63: a program

compilation might consist of country music, classical music). It is obvious that the

second audio file consists of a music single of one song.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Logan to explicitly provide for the second audio file to consist of a music single of a song, motivation being making it possible for subscribers to request one song desired by them at any time instead of having to subscribe to the entire compilation of songs as in a CD, thus making the system attractive to subscribers.

As to claim 47, Logan discloses the method of claim 35 (as rejected above) but does not explicitly disclose, wherein the first audio file comprises an advertising jingle. However, Logan discloses making announcements between program segments (col. 4, lines 44-47: announcements between program segments) and providing a chime preceding a program (col. 13, lines 10-12: an audible cue signal, such as a distinctive tone or chime, might immediately precede a passage).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Logan to explicitly provide for the first audio file to comprise an advertising jingle to apprise the user of the coming advertisement that is targeted to the individual subscriber. .

9.   **Claims 36, 38 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al., U.S. Patent No. 5,721,827 (hereinafter referred to as Logan) as applied to claim 1 and in further view of Wolfe et al., U.S. Patent No. 5,931,901 (hereinafter referred to as Wolfe).**

As to claim 36, Logan discloses the method of claim 35 (as rejected above) and further discloses, further comprising transmitting (col. 5, lines 20-21: the host sever periodically transmits a download compilation file upon receiving a request) the combined audio file to a device onto which each transmitted combined audio file is saved (col. 5, lines 27-28: the download compilation is transferred to the program data store 107 – *saved* – in the player 103; col. 7, lines 1-3: and moved from the storage unit 145 into local storage at 107) for later playback. Logan does not explicitly disclose transmitting to plurality of devices. Wolfe discloses transmitting combined audio file to a plurality of devices (col. 3, lines 50-53: a central processing unit which interfaces with a plurality of subscriber operating PCs or other device capable of receiving individualized content for audio production).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Logan to explicitly provide for transmitting the combine audio file to a plurality of devices on to which the transmitted file could be saved for later playback thus making the system attractive to subscribers.

As to claim 38, Logan discloses the method of claim 35 (as rejected above) and further discloses, wherein the royalty payment is calculated based on a number of times the combined audio file (col. 20, lines 10-12: royalty payment to be calculated as a value calculated by the executable formula; col. 27, lines 8-31: maintains royalty payment records; the extent each program segment was actually performed; the precise extent to which advertising was actually presented) has been transmitted and saved by

users. Furthermore, Wolfe discloses determining royalty fees due to the owner of the audio file based on the "play" statistics (column 5, lines 34-37).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for Logan to explicitly provide for calculating royalty payments based on the number of times the combined audio file has been transmitted and saved by users thus providing for payment to content owners from the advertising revenues while providing content to subscribers free of charge thus making the system attractive to subscribers.

As to claim 42, Logan discloses the method of claim 35 (as rejected above) but does not explicitly disclose, wherein when the combined audio file is played, a portion of the audio file containing the advertising content is played before another portion of the combined audio file containing the non advertising content. However, Logan teaches sequencing (col. 7, lines 8-10: identifies the order in which program segments are to be played) of downloading for playing programs. Examiner notes that it would be a business decision to append advertisement to play before another portion of the combined audio file is played.

However, Wolfe discloses that the advertisement is appended to the beginning of the audio file (column 6, lines 32-39: advertiser's message for each piece is appended as a leader) prior to being made available for downloading. It is obvious that when the combined audio file is played, a portion of the combined audio file containing the

advertising content is played before another portion of the combined audio file

containing the non-advertising content.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention for Logan to explicitly provide for playing the advertising content

portion before playing the non-advertising content thus ensuring subscriber's exposure

to the advertisement, thereby, making the system attractive to advertisers while

providing free content to subscribers.

As to claim 43, Logan disclose the method of claim 35 (as rejected above) but

does not explicitly disclose, wherein the combined audio file is configured so that a

portion of the combined audio file containing the advertising content cannot be easily

removed from the combined audio file. However, Logan teaches subscribers'

acceptance of advertising content appended to non-advertising content for minimizing

cost (col. 9, lines 7-11: indication of the amount of advertising which is acceptable to

defray advertising costs, ranging from fully advertised programming for minimum

subscription charges etc; col. 21, lines 48-50: the subscriber desires to pay minimum

charge and is willing to accept sufficient advertising content to achieve that goal). It is

obvious that advertising content is not removed when subscribers opt for reduced cost.

Furthermore, Wolfe discloses advertising and non advertising content to be inseparable

(column 3, lines 1-2: single inseparable stream).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention for Logan to explicitly provide for ensuring that advertising content

cannot be easily removed from the combined audio file thus ensuring subscriber's

exposure to the advertisement, thereby, making the system attractive to advertisers

while providing free content to subscribers.

10.   **Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

Logan et al., U.S. Patent No. 5,721,827 (hereinafter referred to as Logan) as

applied to claim 1 and in further view of Schulhof et al., U.S. Patent No. 5,557,541

(hereinafter referred to as Schulhof).

        As to claim 49, Logan discloses the method of claim 35 (as rejected above) but

does not explicitly disclose, wherein the at least one device comprises an external

playback device.

        Schulhof discloses external playback device (col. 4, line 64 – col. 5, line 13: a

playback mechanism for retrieving the stored data from the storage medium and for

playing through an external audio amplifier, an automobile radio or a walkman).

        Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention for Logan to explicitly provide for an external playback device for

receiving the stored audio thus making the system more attractive to the subscribers,. .

11.   **Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

Logan et al., U.S. Patent No. 5,721,827 (hereinafter referred to as Logan) as

applied to claim 1 and in further view of Wolfe et al., U.S. Patent No. 5,931,901

(hereinafter referred to as Wolfe) and Willibanks, U.S. Patent No. 5,703,995).

As to claim 41, Logan discloses the method of claim 35 (as rejected above) and

further discloses, wherein the act of receiving the first and second audio files comprise:

accepting an upload of the first audio file (col. 5, lines 53-67: this upload occurs

at the same time a player establishes a download connection and occurs prior to the

download of the compilation; programming, in addition to the specifically requested

programming, are appended to the compilation) over a computer network. Examiner

notes that appended content includes advertising;

accepting an upload of the second audio file (col. 5, lines 53-67: this upload

occurs at the same time a player establishes a download connection and occurs prior to

the download of the compilation) over a computer network; and

confirming that the first audio file and second audio file are in the same file format

(col. 27, lines 37-40: the programs which reside in the program database are formatted

in accordance with a standard structure; col. 38, lines 8-10: adhere to the format set

forth in the article templates) to facilitate combination of the first and second audio files

into the combined audio file.

Moreover, Wolfe discloses storing data units in the same file format (col. 9, lines

storing the data units in one of analog or digital formats). And Willibanks teaches to

convert digital audio information into a compatible format (col. 5, lines 45-50: convert

the received digital audio information into a signal format compatible with the audio in

signal).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention for Logan to explicitly provide for confirming that the first and the

second audio files are in the same file format, motivation being to be able to append

files together into a combined single audio, for transmittal to and saving by subscribers,

thus making the system attractive to subscribers and to advertisers.

Response to Arguments

12.   Applicant's remarks, submitted on February 25, 2011 have been considered.

Examiner's response follows:

a.   **Claim rejections under 35 USC 102:**

        Applicant's arguments with respect to Claims 35-37 have been fully

considered but are moot in view of new ground of rejection.

b.   With regard to, as amended, independent claim 35, Applicant argues that

Willbanks does not teach or suggest (i) making a combined audio file available for

download in the manner recited in claim 35, (ii) the novel method of making a combined

audio file accessible for download free of charge, and (iii) receiving a payment from a

first party and distributing at least a portion of the payment to the second party.

Examiner respectfully disagrees and notes that claims are given their broadest

reasonable interpretation in light of the supporting disclosure and limitations appearing

in the specification but not recited in the claim are not read into the claim (MPEP 2106 II

C). Examiner further notes that Willbanks discloses making the combine audio file

accessible for download to the plurality of users (col. 7, lines 44-65: the audio files are

provided within the audio storage device 148, or may be downloaded to the audio

controller, once the mixed audio file is stored it is accessible to multiple users) as

recited in amended claim 35. Moreover, Logan discloses making the combined audio

file accessible for download (col. 4, lines 3-14: the player includes modem for

downloading the program information; the modem is connected to an Internet service

provider which provides access to the Internet; the service provider, in turn, is

connected to the host server via an Internet link). Therefore, Applicant's argument is

not persuasive and is moot in view of new grounds of rejection. Applicant's arguments

with regard to providing accessibility free of charge and retrieving payment from first

party and distributing to a second party are moot in view of new ground of rejection.

      c.   Examiner further notes that citations by Examiner are representative of the

teachings in the cited arts and are applied to the specific limitations within the individual

claim, other passages and figures may apply as well and Applicant is to consider fully

the entire references as potentially teaching all or part of the claimed invention, as well

as the context of the passage as taught by the prior arts or disclosed by the Examiner.

      d.   In regard to dependent claims 36 and 37, these claims depend directly on

claim 35. Therefore, Applicant's arguments are not persuasive or are moot for the

reasons stated in (b) and (c) above.

Conclusion

13.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is filed

within TWO MONTHS of the mailing date of this final action and the advisory action is

not mailed until after the end of the THREE-MONTH shortened statutory period, then

the shortened statutory period will expire on the date the advisory action is mailed, and

any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date

of the advisory action. In no event, however, will the statutory period for reply expire

later than SIX MONTHS from the date of this final action.

11.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kris Mittal whose telephone number is (571)270-5492.

The examiner can normally be reached on Monday-Thursday 7.30 AM-5.00 PM.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

        Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KM
4/4/11

/JOHN G. WEISS/

Supervisory Patent Examiner, Art Unit 3688